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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,921	12/12/2000	Mary L. Richardson	EMD0001-US	3793

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EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,921

Applicant(s)

RICHARDSON, MARY L.

Examiner

C. Michelle Colon

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/3/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on December 12, 2000. Claims 1-67 are now pending in this application.

Information Disclosure Statement

2. The examiner has reviewed the patents and publications supplied in the Information Disclosure Statement (IDS) provided on July 3, 2001.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-14, 22-37, 42, 44-56 and 58-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social

sciences) and therefore are found to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the steps of method claims 1-14, 22-37, 42, 44-56 and 58-67 merely recite providing an employment placement service; however, the steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper and without the need of a computer or other technology.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention uses employer and applicant information and criteria (i.e., concrete) to perform employment placement (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-14, 22-37, 42, 44-56 and 58-67 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-67 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 5,884,270).

As per claim 1, Walker et al. discloses a method for providing an employment placement service comprising the steps of:

(a) broadcasting job listings of employers (col. 6, lines 10-39; col. 7, lines 15-52; The system allows requestors (i.e., employers) to broadcast their job listings.);

(b) providing employer information about the employers (col. 7, lines 15-22; Requestors provide various information such as number of employees, location of offices, job descriptions, etc.); and

(c) exchanging applicant information between applicants and the employers (col. 8, lines 38-50; col. 15, lines 56-67; Based upon the search requests, the system provides applicable information to the requestors and parties (i.e., job applicants).).

Walker et al. discloses charging requestors for certain transactions performed (col. 18, line 61-col. 19, line 4). Walker et al. does not expressly disclose charging the employers only for job listings that produce hirings.

However, it is old and well known in the recruitment industry to charge employers only for leads that produce hirings. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to charge employers only for job listings that produce hirings because doing so is well known in the industry and further, incentivizes recruiters to only supply qualifying applicants that are relevant to employers' criteria.

As per claim 2, Walker et al. does not expressly disclose the method of claim 1, wherein the step of charging comprises charging the employers only for job listings that produce hirings for critical hire positions. Walker et al. discloses charging requestors for certain transactions performed (col. 18, line 61-col. 19, line 4). It is old and well known in the recruitment industry to charge employers only for leads that produce certain hirings. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to charge employers only for job listings that produce hirings for certain positions because doing so is well known in the industry and further, incentivizes recruiters to only supply qualifying applicants that are relevant to employers' criteria.

As per claim 3, Walker et al. discloses the method of claim 1, further comprising the step of giving an applicant a signing bonus if the applicant uses the service to locate an employer and if the employer hires the applicant (col. 6, lines 25-38; The system discloses giving applicants bonuses.).

As per claim 4, Walker et al. does not expressly disclose the method of claim 3, wherein the applicant must be hired for a critical hire position. However, it is well known in the art to use signing bonuses to encourage individuals to

apply for particular jobs, especially if a position is critical, such as needing to be filled immediately. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to give signing bonuses to applicants of certain positions because doing so is a well known practice in the art and further, incentivizes individuals to apply for a position that is critical to the employer.

As per claim 5, Walker et al. does not expressly disclose the method of claim 1, further comprising entering applicants in a drawing for a prize, wherein the applicants have been hired through the service during a specified period. However, entering applicants into a drawing for a prize provides similar incentives as giving applicants a signing bonus in that both encourage individuals to apply for jobs. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to enter applicants in a drawing for a prize because doing so incentivizes individuals to apply for positions.

As per claim 6, Walker et al. discloses the method of claim 5, wherein the applicants who have been hired through the service during a specified period are applicants for non-critical hire positions (col. 7, lines 15-52).

As per claim 7, Walker et al. discloses the method of claim 1, wherein the employer information is uniform criteria for all of the employers (col. 7, lines 15-52; The system uses a database for storing employer information. The database comprises certain fields for all employers.).

As per claim 8, Walker et al. does not expressly disclose the method of claim 1, wherein the employers are health care providers. However, employment placement applies to all industries. Thus, at the time of the invention, it would

have been obvious for a health care provider to utilize an employment placement service since, like many businesses, they require qualified applicants to fill certain positions.

As per claim 9, Walker et al. discloses the method of claim 1, wherein the step of providing employer information further comprises providing employer information about employers that are not posting job listings on the service (col. 7, lines 15-22).

As per claim 10, Walker et al. discloses the method of claim 1, further comprising the step of searching the job listings, the employer information, and the applicant information (col. 7, lines 41-52; col. 8, lines 38-67).

As per claim 11, Walker et al. discloses the method of claim 1, wherein the step of providing employer information comprises searching for an employer matching particular employer information desired by an applicant (col. 7, lines 1-41).

As per claim 12, Walker et al. discloses the method of claim 11, wherein if the searching does not return a matching employer, then the method further comprises the steps of:

- (i) storing the particular employer information desired by the applicant (col. 4, lines 49-67; Figures 2B and 2C; The system maintains employer and applicant databases.);

- (ii) periodically searching for the particular employer information desired by the applicant (col. 8, lines 38-67); and

(iii) notifying the applicant when the searching returns a matching employer (col. 8, line 38-col. 9, line 5).

As per claim 13, Walker et al. discloses the method of claim 12, wherein the step of notifying the applicant comprises sending an email to the applicant (col. 8, line 38-col. 9, line 22).

As per claim 14, Walker et al. discloses the method of claim 12, further comprising the steps of:

storing particular employer information desired by multiple applicants and analyzing the stored particular employer information to provide information as to demand for certain employer criteria (col. 19, lines 49-51; The system monitors transactions between requestors and parties and therefore, monitors the demand for certain employers.).

As per claim 15, Walker et al. discloses the method of claim 1, wherein the step of exchanging applicant information between applicants and employers comprises storing applicant qualifications in a database searchable by the employers (col. 4, lines 49-67; Figures 2B and 2C; The system maintains employer and applicant databases.).

As per claim 16, Walker et al. discloses the method of claim 15, further comprising searching the database for an applicant matching particular applicant qualifications desired by an employer (col. 4, lines 49-67; Figures 2B and 2C).

As per claim 17, Walker et al. discloses the method of claim 16, wherein if the searching does not return a matching applicant, then the method further comprises the steps of:

(i) storing the particular applicant qualifications desired by an employer (col. 4, lines 49-67; Figures 2B and 2C; The system maintains employer and applicant databases.);

(ii) periodically searching for the particular applicant qualifications desired by an employer (col. 8, lines 38-67); and

(iii) notifying the employer when the searching returns a matching applicant (col. 8, line 38-col. 9, line 5).

As per claim 18, Walker et al. discloses the method of claim 17, wherein the step of notifying the employer comprises sending an email to the employer (col. 8, line 38-col. 9, line 22; The system sends query results electronically to the employer.).

As per claim 19, Walker et al. discloses the method of claim 17, further comprising the steps of:

storing particular applicant qualifications desired by multiple employers and analyzing the stored particular applicant qualifications to provide information as to demand for certain specialties (col. 19, lines 49-51; The system monitors transactions between requestors and parties and therefore, monitors the demand for certain parties.).

As per claim 20, Walker et al. discloses the method of claim 15, wherein the qualifications are stored in an applicant file and the applicant file is marked inactive such that the applicant file is not searched (col. 8, lines 7-18; The system cross-references fields in the database to allow for indexing by verified information.).

As per claim 21, Walker et al. discloses the method of claim 1, wherein exchanging applicant information between applicants and employers is accomplished by electronic mail (col. 9, lines 6-22; The system establishes communication between applicants and employers either in real-time or non-real-time communication channels.).

As per claim 22, Walker et al. discloses the method of claim 1, further comprising the step of charging the employers a subscription fee separate from charges for the job listings that produce hirings (col. 19, lines 34-51).

As per claims 23-26, Walker et al. does not expressly disclose the method of claim 1, wherein the step of broadcasting comprises distributing a paper that contains the job listings, wherein the paper includes a response card, wherein the step of providing employer information comprises providing uniform employer criteria in the job listings, and wherein the step of exchanging applicant information comprises receiving response cards from the applicants. However, Walker et al. does disclose an automated fashion using computers and a network to broadcast job listings, provide employer information and receive responses from applicants, including telephone communication, which accomplishes the same result as the recited paper distribution (col. 6, lines 50-59; col. 7, lines 15-52; col. 8, lines 38-50; col. 15, lines 56-67). Thus, at the time of the invention, it would have been obvious to one of ordinary skill in the art to automate a well-known activity since it accomplishes the same result in a more efficient and expeditious way. It was known at the time of the invention that merely providing an automated way to replace a well-known activity, which

accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claims 27-67 recite substantially similar limitations as claims 1-26.
Therefore, claims 27-67 are rejected on the same basis as claims 1-26.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- McGovern et al. (U.S. 5,987,768) discusses a computerized job search system;
- Ogden (U.S. 6,311,164) discusses a remote job application method;
- Taylor (U.S. 5,832,497) discusses an electronic automated information exchange and management system;
- Thompson et al. (U.S. 6,675,151) discusses a system and method for substitute fulfillment; and
- Reuning (U.S. 6,381,592) discusses a candidate chaser system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 [Official Communications; including After Final
communications labeled "Box AF"]

703-746-7202 [For status inquiries, draft communication,
labeled "Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA 7th floor receptionist.


cmc

August 6, 2004


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